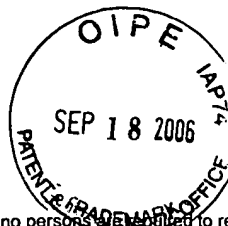


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9400-28

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on September 14, 2006

Signature

Typed or printed
name

Traci A. Brown

Application Number

10/624,320

Filed

July 22, 2003

First Named Inventor

Charles Atchison

Art Unit

2163

Examiner

Charles Edward Piggush

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,011

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

D. Scott Moore

Typed or printed name

(919) 854-1400

Telephone number

September 14, 2006

Date

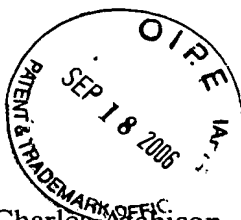
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE--EXAMINING GROUP 2163**

In re: Charles Atchison

Serial No.: 10/624,320

Filed: July 22, 2003

For: METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR
QUERYING A DATABASE FOR EMPLOYEE DATA AND ORGANIZING THE
OBTAINED DATA

Confirmation No.: 7307

Examiner: Charles Edward Lu

Group Art Unit: 2163

Date: September 14, 2006

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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Traci A. Brown

**REASONS IN SUPPORT OF APPLICANT'S PRE-APPEAL
BRIEF REQUEST FOR REVIEW AND INTERVIEW SUMMARY**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which have been extended indefinitely

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed June 14, 2006 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Applicant respectfully submits that the rejections of the currently pending claims are clearly erroneous because all pending claims meet the statutory requirements of 35 U.S.C. §101 and many of the recitations of the pending claims are not met by the cited references for

at least the reasons discussed herein and in Applicant's previously filed Amendment and Request For Reconsideration of April 11, 2006. Therefore, Applicant respectfully requests review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicant will only discuss the recitations of independent Claims 1, 9, and 17 with regard to the rejections based on cited art and the statutory nature of independent Claim 9.

Interview Summary

Applicant wishes to thank the Examiner for discussing the pending claims with Applicant's representative, Scott Moore (Reg. No. 42,011) on September 1, 2006. During the interview, no agreement was reached as to the patentability of the pending claims. Applicant respectfully requests that the present remarks constitute an Interview Summary pursuant to MPEP §713.04.

Section 101 Rejections

Independent Claim 9 stands rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. (Final Action, page 4). The Final Action states "the claimed means are interpreted as software per se, which is functional descriptive material per se and therefore non-statutory." (Final Action, page 4). Applicant respectfully disagrees. The recitations of independent Claim 9 are written in means plus function form. According to Section 2181, part II of the Manual Of Patent Examining Procedure (MPEP), "35 U.S.C. 112 sixth paragraph states that a claim limitation expressed in means-plus-function language 'shall be construed to cover the corresponding structure described in the specification and equivalents thereof.' 'If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.' *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc)." The functionality recited in independent Claim 9 is described, for example, with reference to FIG. 4 at page 8, line 24 through page 10, line 19 of the Specification. Moreover, the Specification explains that the blocks shown in FIG. 4 can be implemented by

computer program instruction stored in a computer-readable memory and/or other hardware as follows:

It will be understood that each block of the flowchart and/or block diagram illustrations, and combinations of blocks in the flowchart and/or block diagram illustrations, may be implemented by computer program instructions and/or hardware operations. **These computer program instructions may be provided to a processor of a general purpose computer, a special purpose computer, or other programmable data processing apparatus to produce a machine, such that the instructions, which execute via the processor of the computer or other programmable data processing apparatus, create means and/or circuits for implementing the functions specified in the flowchart and/or block diagram block or blocks.**

These computer program instructions may also be stored in a computer usable or computer-readable memory that may direct a computer or other programmable data processing apparatus to function in a particular manner, such that the instructions stored in the computer usable or computer-readable memory produce an article of manufacture including instructions that implement the function specified in the flowchart and/or block diagram block or blocks.

The computer program instructions may also be loaded onto a computer or other programmable data processing apparatus to cause a series of operational steps to be performed on the computer or other programmable apparatus to produce a computer implemented process such that the instructions that execute on the computer or other programmable apparatus provide steps for implementing the functions specified in the flowchart and/or block diagram block or blocks. (Specification, page 8, lines 2 - 23; emphasis added).

Applicant submits that the Specification provides structural support for the means plus function recitations of independent Claim 9 in the form of FIG. 4 and the description reproduced above explaining that the blocks of FIG. 4 may be implemented in hardware, a computer/data processing apparatus that executes computer program instructions, and/or as computer program instructions stored in a computer-readable memory.

In response to this argument, the Final Action states that Applicant has pointed out "that implementation can be through computer program instructions and/or hardware. Because of the use of the term 'and/or', the claimed system is being broadly and reasonably interpreted as a system of computer program instructions, which is software, per se." Applicant submits, however, that the Final Action's characterization of Applicant's previous response is misleading. As reproduced above, the Specification states that the computer program instructions can be provided to a processor of a computer or data processing

apparatus to produce a machine such that **the instructions when executed by the computer or data processing apparatus create means for implementing the functions specified in the flowchart.** Applicant submits that a computer or data processing system that is configured to execute computer program instructions clearly qualifies as statutory subject matter under 35 U.S.C. §101.

For at least the foregoing reasons, Applicant respectfully requests that the present application be reviewed and that the rejection of independent Claim 9 as failing to satisfy the requirements of 35 U.S.C. §101 be reversed by the appeal conference prior to the filing of an appeal brief.

Independent Claims 1, 9, and 17 are Patentable

Independent Claims 1, 9, and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over United States Patent Publication No. 2004/0110191 to Handsaker et al. (hereinafter "Handsaker") in view of United States Patent No. 6,359,892 to Szlam (hereinafter "Szlam"). (Final Action, page 5). Independent Claim 1 is directed to a method of querying an employee database and recites, in part:

defining a plurality of query criteria;
querying the employee database by applying respective ones of the query criteria to respective ones of a plurality of employees;
providing a plurality of folders, respective ones of the plurality of folders corresponding to respective ones of the plurality of query criteria; and
creating a plurality of workbooks containing results from querying the employee database for respective ones of the plurality of folders,
respective ones of the plurality of workbooks being associated with respective ones of the plurality of employees that have results for respective ones of the plurality of query criteria corresponding to respective ones of the plurality of folders.

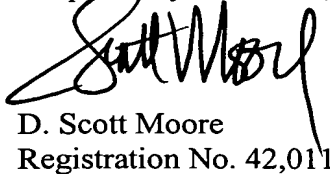
Independent Claims 9 and 17 include similar recitations. As highlighted above, an employee database is queried and workbooks, which are respectively associated with the employees, are then created to store the results of the query. In sharp contrast, Handsaker describes a system in which workbooks are created by a user, administrator, system and/or automated process. (Handsaker, paragraph 44). Handsaker explains that a system 300 (FIG. 3) is used to generate and process workbooks. (Handsaker, paragraph 71). Applicant cannot find any disclosure in Handsaker that describes the generation of workbooks that contain the results of a query

operation of an employee database. The Final Action cites FIG. 5 of Handsaker as showing a query of an employee database (Final Action, page 5). Applicant respectfully disagrees with this interpretation of FIG. 5. As explained in paragraph 115 of Handsaker, FIG. 5 illustrates a view of a virtual workbook 205 using the network browser module 350. Rather than being a query of an employee database, the query shown in FIG. 5 of Handsaker is actually a query of a virtual workbook. The Final Action on page 3 acknowledges that Handsaker teaches querying a virtual workbook, but nevertheless maintains the rejection. Applicant submits that the Final Action fails to recognize the distinction that the independent claims recite that a database query is performed first and then workbooks are created that store the results of the database query. Handsaker, by contrast, describes querying workbooks that have previously been created.

The Final Action cites Szlam as teaching the use of folders for storing information. (Final Action, page 6). Applicant submits, however, that even if Handsaker and Szlam were to be combined, their teachings do not disclose or suggest providing folders corresponding to respective ones of the plurality of query criteria as Handsaker merely describes a browser that can be used to query a workbook and does not provide any teaching with respect to reserving storage locations for query criteria. Moreover, Applicant submits that there would be no motivation to combine the teachings of Handsaker and Szlam because Handsaker contains no disclosure therein about the desirability of organizing the workbooks in separate locations.

For at least the foregoing reasons, Applicant respectfully requests that the present application be reviewed and that the rejection of independent Claims 1, 9, and 17 be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



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